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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,043	11/20/2003	Bruce R. Berkson	BERK-42268	3158
26252	7590	05/30/2006	EXAMINER	
KELLY LOWRY & KELLEY, LLP 6320 CANOGA AVENUE SUITE 1650 WOODLAND HILLS, CA 91367			AYRES, TIMOTHY MICHAEL	
			ART UNIT	PAPER NUMBER
			3637	

DATE MAILED: 05/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/719,043	Applicant(s) BERKSON ET AL.	
	Examiner Timothy M. Ayres	Art Unit 3637	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-27 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. ____.  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____.   | 6) <input type="checkbox"/> Other: ____.                                    |

### **DETAILED ACTION**

This is a first office action on the merits of application SN 10/719,043.

#### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 3, 15, and 23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is unclear from the specification and the drawing as to what features and properties the disc entry ramp (30) has other than being the bottom of the housing.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 12, 21, 26, and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. Claim 12 recites the limitation "the locking means" in line 1. There is insufficient antecedent basis for this limitation in the claim.

6. Claim 21 recites the limitation "the locking pin" in line 2. There is insufficient antecedent basis for this limitation in the claim.
7. Claim 26 recites the limitation "the locking means" in line 1. There is insufficient antecedent basis for this limitation in the claim.
8. Claim 27 recites the limitation "the locking pin" in line 2. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

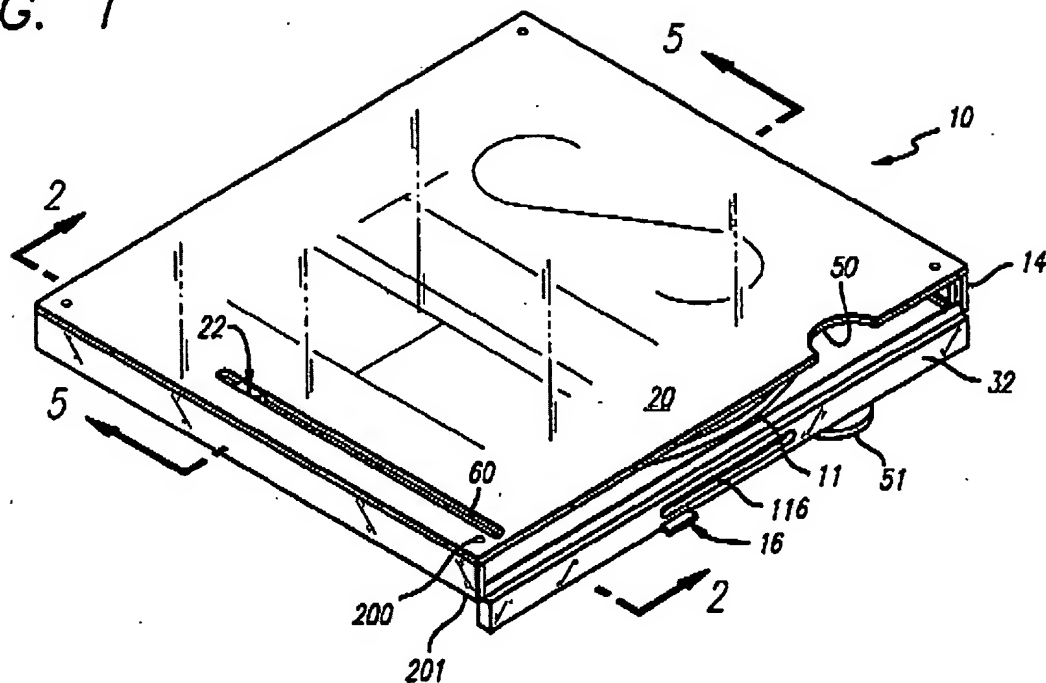
9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

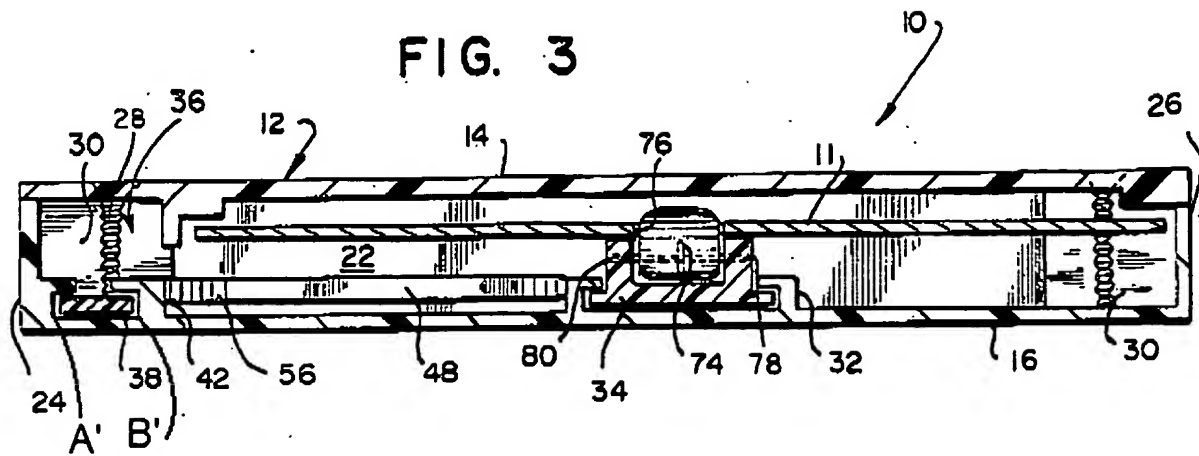
10. Claims 1, 3-5 and 8-11 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 5,495,939 to Castritis. Castritis teaches a handheld disc storage device (10) that has a housing (14) with an aperture to receive a disc into an interior cavity. A manual-actuated slider (18) moves along guide tracks (110,111) as seen in figure 5. A disc entry ramp (28) is disposed adjacent to the aperture and a hook (106) on the slider (18) engages a portion of the disk. A manually actuated lever-mechanism is a lever (22,58) that travels in a slot (60) and is connected to the slider (18). Protuberances (201) extend from a bottom surface and depressions (200) on the top surface accept the protuberances (201) of a second housing when stacking. Means for locking (16) the disc within the housing include a door (32) that has a snap fit (fig 7).

FIG. 1



Castritis '939 Figure 1

11. Claims 1, 3-8, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 4,728,157 to David. David teaches a handheld disc storage device (10) that has a housing (12) with an aperture to receive a disc into an interior cavity. A manual-actuated slider (34) moves along guide tracks (32) as seen in figure 3. A disc entry ramp (16) is disposed adjacent to the aperture and a hook (88) on the slider (34) engages a portion of the disk. A manually actuated lever-mechanism is a lever (38) that travels in a slots (A',B') formed in the housing as seen in marked up figure 3 below and is connected to the slider (34) by a pivot arm (48). Means for locking the disc within the housing includes a door (18) that has spring (21) to bias shut.



David '157 Figure 3

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

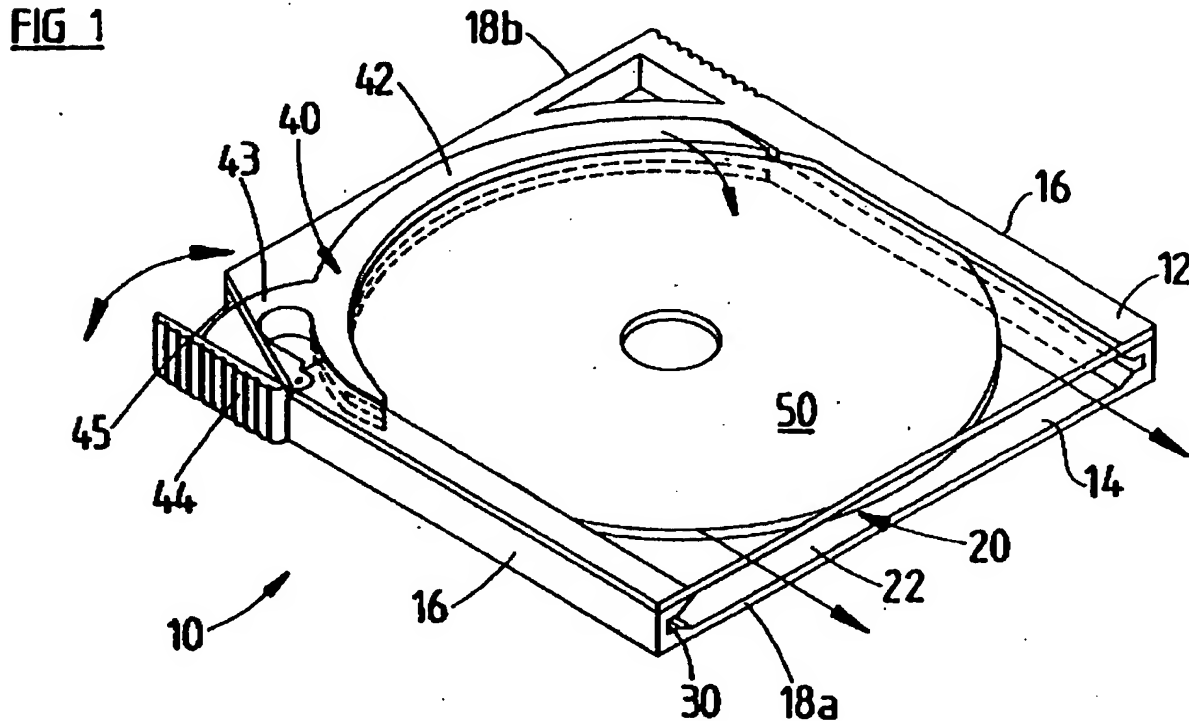
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

14. Claims 2, 14, 15, 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,495,939 to Castritis in view of US Patent 5,676,246 to

Gloger. Castritis discloses every element as claimed and discussed above except disc tracks formed in the housing. Gloger teaches a disc storage device that has disc tracks (30) formed in the housing (16). At the time of the invention it would have been obvious for a person of ordinary skill in the art to modify the disc storage device of Castritis by adding disc tracks in the housing walls as taught by Gloger to help prevent the surfaces of the disc to contact the top or bottom of the contains (Gloger '246, Col. 2, lines 18-29).



Gloger '246 Figure 1

15. Claims 2, 14 –17, and 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 4,728,157 to David in view of US Patent 5,676,246 to Gloger. David discloses every element as claimed and discussed above except disc

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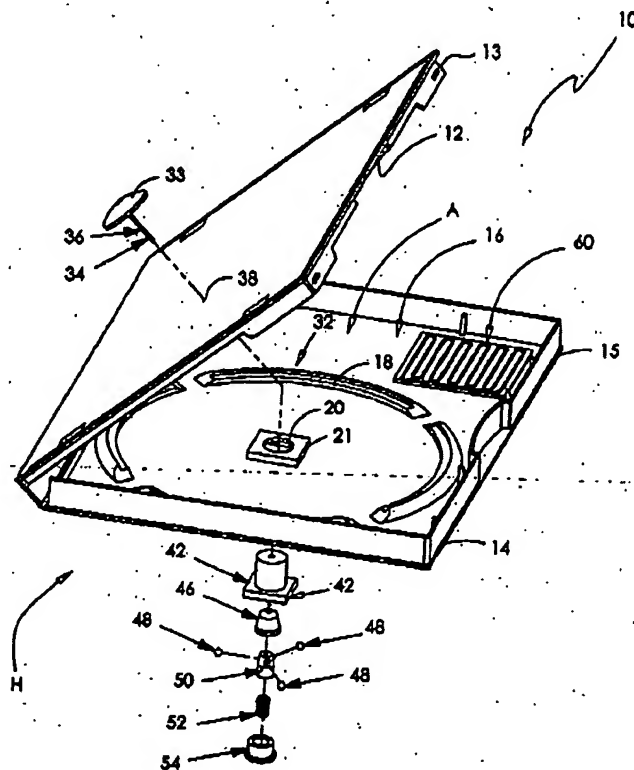
tracks formed in the housing. Gloger teaches a disc storage device that has disc tracks (30) formed in the housing (16). At the time of the invention it would have been obvious for a person of ordinary skill in the art to modify the disc storage device of David by adding disc tracks in the housing walls as taught by Gloger to help prevent the surfaces of the disc to contact the top or bottom of the contains (Gloger '246, Col. 2, lines 18-29).

16. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 4,728,157 to David in view of US Patent 5,495,939 to Castritis. David discloses every element as claimed and discussed above except protuberances extending from a surface that fit in depressions on a second housing to allow the housings to be stacked. Castritis teaches a handheld disc storage device (10) that has a housing (14) with an aperture to receive a disc into an interior cavity. Protuberances (201) extend from a bottom surface and depressions (200) on the top surface accept the protuberances (201) of a second housing when stacking. At the time of the invention it would have been obvious for a person of ordinary skill in the art to modify the disc storage device of David by adding protuberance and depressions as taught by Castritis to allow for the stacking of housing without slippage (Castritis '939, Col. 4m lines 12-18).

17. Claim 12 rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,495,939 to Castritis in view of US Patent 6,896,133 to Spagna. Castritis discloses



every element as claimed and discussed above except the locking means comprising opposing apertures formed in the housing and alignable with a central aperture of the disc for acceptance of a locking pin. Spagna teaches a disc storage device with a locking mechanism (40) that has opposing apertures (38,20) that line up with the central opening of a disc. A locking pin (34) passes through those apertures and is locked in place to secure the disc. At the time of the invention it would have been obvious for a person of ordinary skill in the art to modify the disc storage device of Castritis by adding the locking mechanism as taught by Spagna to allow a theft deterrent feature to be easily disabled by an authorized person (Spagna '133, Col. 2, lines 3-6).



Spagna '133 Figure 1

18. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,495,939 to Castritis in view of US Patent 6,817,025 to Boorman and US Patent 6,112,894 to Kikuchi. Castritis discloses every element as claimed and discussed above except each of the housings having apertures to receive a locking pin and a case adapted for storing multiple housings stacked with the locking pin extending from one end of the case and out an opposite end of the case. Boorman teaches multiple disc storage devices (20) with apertures (55) to receive a locking pin (62) when stacked. At the time of the invention it would have been obvious for a person of ordinary skill in the art to modify the storage device of Castritis by adding apertures and a locking pin as taught by Boorman to allow for vertical stacking.

19. Castritis in view of Boorman does not expressly disclose a case adapted for storing multiple housings stacked with the locking pin extending from one end of the case and out an opposite end of the case. Kilkuchi teaches a case (45) that has a locking pin (43) extending through the ends of the case and apertures in discs (44). At the time of the invention it would have been obvious for a person of ordinary skill in the art to modify the storage device of Castritis in view of Boorman by adding a case with locking pin extending through the case as taught by Kilkuchi to provide a simple structure to hold multiple discs and can withstand transportation (Kilkuchi '894, Col. 3, lines 6-9).

20. Claim 12 rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 4,728,157 to David in view of US Patent 6,896,133 to Spagna. David discloses every element as claimed and discussed above except the locking means comprising opposing apertures formed in the housing and alignable with a central aperture of the disc for acceptance of a locking pin. Spagna teaches a disc storage device with a locking mechanism (40) that has opposing apertures (38,20) that line up with the central opening of a disc. A locking pin (34) passes through those apertures and is locked in place to secure the disc. At the time of the invention it would have been obvious for a person of ordinary skill in the art to modify the disc storage device of David by adding the locking mechanism as taught by Spagna to allow a theft deterrent feature to be easily disabled by an authorized person (Spagna '133, Col. 2, lines 3-6).

21. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 4,728,157 to David in view of US Patent 6,817,025 to Boorman and US Patent 6,112,894 to Kikuchi. David discloses every element as claimed and discussed above except each of the housings having apertures to receive a locking pin and a case adapted for storing multiple housings stacked with the locking pin extending from one end of the case and out an opposite end of the case. Boorman teaches multiple disc storage devices (20) with apertures (55) to receive a locking pin (62) when stacked. At the time of the invention it would have been obvious for a person of ordinary skill in the

art to modify the storage device of David by adding apertures and a locking pin as taught by Boorman to allow for vertical stacking.

22. David in view of Boorman does not expressly disclose a case adapted for storing multiple housings stacked with the locking pin extending from one end of the case and out an opposite end of the case. Kilkuchi teaches a case (45) that has a locking pin (43) extending through the ends of the case and apertures in discs (44). At the time of the invention it would have been obvious for a person of ordinary skill in the art to modify the storage device of David in view of Boorman by adding a case with locking pin extending through the case as taught by Kilkuchi to provide a simple structure to hold multiple discs and can withstand transportation (Kilkuchi '894, Col. 3, lines 6-9).

23. Claims 18, 19, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 4,728,157 to David in view of US Patent 5,676,246 to Gloger as applied to claim 14 above, and further in view of US Patent 5,495,939 to Castritis. David in view of Gloger disclose every element as claimed and discussed above except protuberances extending from a surface that fit in depressions on a second housing to allow the housings to be stacked. Castritis teaches a handheld disc storage device (10) that has a housing (14) with an aperture to receive a disc into an interior cavity. Protuberances (201) extend from a bottom surface and depressions (200) on the top surface accept the protuberances (201) of a second housing when stacking. At the time of the invention it would have been obvious for a person of

ordinary skill in the art to modify the disc storage device of David in view of Gloger by adding protuberance and depressions as taught by Castritis to allow for the stacking of housing without slippage (Castritis '939, Col. 4m lines 12-18).

24. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,495,939 to Castritis in view of US Patent 5,676,246 to Gloger as applied to claim 14 above, and further in view of US Patent 6,896,133 to Spagna. Castritis in view of Gloger discloses every element as claimed and discussed above except the locking means comprising opposing apertures formed in the housing and alignable with a central aperture of the disc for acceptance of a locking pin. Spagna teaches a disc storage device with a locking mechanism (40) that has opposing apertures (38,20) that line up with the central opening of a disc. A locking pin (34) passes through those apertures and is locked in place to secure the disc. At the time of the invention it would have been obvious for a person of ordinary skill in the art to modify the disc storage device of Castritis in view of Gloger by adding the locking mechanism as taught by Spagna to allow a theft deterrent feature to be easily disabled by an authorized person (Spagna '133, Col. 2, lines 3-6).

25. Claims 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,495,939 to Castritis in view of US Patent 5,676,246 to Gloger as

applied to claim 14 above, and further in view of US Patent 6,817,025 to Boorman and US Patent 6,112,894 to Kikuchi. Castritis in view of Gloger discloses every element as claimed and discussed above except each of the housings having apertures to receive a locking pin and a case adapted for storing multiple housings stacked with the locking pin extending from one end of the case and out an opposite end of the case. Boorman teaches multiple disc storage devices (20) with apertures (55) to receive a locking pin (62) when stacked. At the time of the invention it would have been obvious for a person of ordinary skill in the art to modify the storage device of Castritis in view of Gloger by adding apertures and a locking pin as taught by Boorman to allow for vertical stacking.

26. Castritis in view of Gloger and Boorman does not expressly disclose a case adapted for storing multiple housings stacked with the locking pin extending from one end of the case and out an opposite end of the case. Kilkuchi teaches a case (45) that has a locking pin (43) extending through the ends of the case and apertures in discs (44). At the time of the invention it would have been obvious for a person of ordinary skill in the art to modify the storage device of Castritis in view of Gloger and Boorman by adding a case with locking pin extending through the case as taught by Kilkuchi to provide a simple structure to hold multiple discs and can withstand transportation (Kilkuchi '894, Col. 3, lines 6-9).

27. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 4,728,157 to David in view of US Patent 5,676,246 to Gloger as applied to claim

14 above, and further in view of US Patent 6,896,133 to Spagna. David in view of Gloger discloses every element as claimed and discussed above except the locking means comprising opposing apertures formed in the housing and alignable with a central aperture of the disc for acceptance of a locking pin. Spagna teaches a disc storage device with a locking mechanism (40) that has opposing apertures (38,20) that line up with the central opening of a disc. A locking pin (34) passes through those apertures and is locked in place to secure the disc. At the time of the invention it would have been obvious for a person of ordinary skill in the art to modify the disc storage device of David in view of Gloger by adding the locking mechanism as taught by Spagna to allow a theft deterrent feature to be easily disabled by an authorized person (Spagna '133, Col. 2, lines 3-6).

28. Claims 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 4,728,157 to David in view of US Patent 5,676,246 to Gloger as applied to claim 14 above, and further in view of US Patent 6,817,025 to Boorman and US Patent 6,112,894 to Kikuchi. David in view of Gloger discloses every element as claimed and discussed above except each of the housings having apertures to receive a locking pin and a case adapted for storing multiple housings stacked with the locking pin extending from one end of the case and out an opposite end of the case. Boorman teaches multiple disc storage devices (20) with apertures (55) to receive a locking pin (62) when stacked. At the time of the invention it would have been obvious for a person

of ordinary skill in the art to modify the storage device of David in view of Gloger by adding apertures and a locking pin as taught by Boorman to allow for vertical stacking.

29. David in view of Gloger and Boorman does not expressly disclose a case adapted for storing multiple housings stacked with the locking pin extending from one end of the case and out an opposite end of the case. Kilkuchi teaches a case (45) that has a locking pin (43) extending through the ends of the case and apertures in discs (44). At the time of the invention it would have been obvious for a person of ordinary skill in the art to modify the storage device of David in view of Gloger and Boorman by adding a case with locking pin extending through the case as taught by Kilkuchi to provide a simple structure to hold multiple discs and can withstand transportation (Kilkuchi '894, Col. 3, lines 6-9).

30. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 4,728,157 to David in view of US Patent 5,676,246 to Gloger and US Patent 5,495,939 to Castritis as applied to claims 22-25 above, and further in view of US Patent 6,896,133 to Spagna. David in view of Gloger and Castritis discloses every element as claimed and discussed above except the locking means comprising opposing apertures formed in the housing and alignable with a central aperture of the disc for acceptance of a locking pin. Spagna teaches a disc storage device with a locking mechanism (40) that has opposing apertures (38,20) that line up with the central opening of a disc. A locking pin (34) passes through those apertures and is locked in



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place to secure the disc. At the time of the invention it would have been obvious for a person of ordinary skill in the art to modify the disc storage device of David in view of Gloger and Castritis by adding the locking mechanism as taught by Spagna to allow a theft deterrent feature to be easily disabled by an authorized person (Spagna '133, Col. 2, lines 3-6).

31. Claim 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 4,728,157 to David in view of US Patent 5,676,246 to Gloger and US Patent 5,495,939 to Castritis as applied to claims 22-25 above, and further in view of US Patent 6,817,025 to Boorman and US Patent 6,112,894 to Kikuchi. David in view of Gloger and Castritis discloses every element as claimed and discussed above except each of the housings having apertures to receive a locking pin and a case adapted for storing multiple housings stacked with the locking pin extending from one end of the case and out an opposite end of the case. Boorman teaches multiple disc storage devices (20) with apertures (55) to receive a locking pin (62) when stacked. At the time of the invention it would have been obvious for a person of ordinary skill in the art to modify the storage device of David in view of Gloger and Castritis by adding apertures and a locking pin as taught by Boorman to allow for vertical stacking.

32. David in view of Gloger, Castritis, and Boorman does not expressly disclose a case adapted for storing multiple housings stacked with the locking pin extending from one end of the case and out an opposite end of the case. Kilkuchi teaches a case (45)

that has a locking pin (43) extending through the ends of the case and apertures in discs (44). At the time of the invention it would have been obvious for a person of ordinary skill in the art to modify the storage device of David in view of Gloger, Castritis, and Boorman by adding a case with locking pin extending through the case as taught by Kilkuchi to provide a simple structure to hold multiple discs and can withstand transportation (Kilkuchi '894, Col. 3, lines 6-9).

### ***Conclusion***

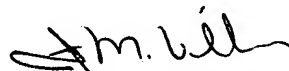
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy M. Ayres whose telephone number is (571) 272-8299. The examiner can normally be reached on MON-THU 8:00 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on (571) 272-6867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TMA  
5/20/06

  
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